REMARKS

Claims 2, 5 through 15, 17 through 21 and 23 through 41 are pending in this application. Claims 33 through 41 have been added by this amendment. Claims 2, 17, 23, 27, 30 and 33 are the independent claims. Claims 2, 7, 17, 23, 27, 30 and 31 have been amended to overcome the Section 103 rejections.

The Examiner rejected claims 2, 5 through 9, 12 through 15, 17 through 21 and 23 through 30 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,526, 520 to Krause in view of U.S. Patent No. 6,372,612 to Watanabe. The Examiner also rejected claims 2, 5 through 15, 17 through 21 and 23 through 30 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,675,507 to Bobo, II in view of U.S. Patent No. 5,870,089 to Fabbio.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 2, 5 through 9, 12 through 15, 17 through 21 and 23 through 30 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,526, 520 to Krause in view of U.S. Patent No. 6,372,612 to Watanabe. Claims 2, 7, 17, 23, 27, 30 and 31 have been amended to overcome the Section 103 rejection. Specifically, claim 2 has been amended to recite, in part:

> "   processing said primary document <u>to locate</u> an <u>un-selected</u> indicator;
> identifying said secondary document <u>associated with</u> said <u>located un-selected</u> indicator; and
> attaching said secondary document to said primary document to encapsulate said secondary <u>document within said primary document</u>."

There is nothing in the Krause patent that discloses or suggests "processing said primary document <u>to locate</u> an <u>un-selected</u> indicator; identifying said secondary document <u>associated with</u> said <u>located un-selected</u> indicator . . .," as recited in claim 2. Instead, the

Krause patent operates only <u>after the selection</u> of a hotspot 55 (indicator) to identify the secondary document based on information in the <u>selected</u> hotspot (see column 4, lines 51 – 65). Similarly, there is nothing in the Watanabe patent that discloses or suggests the above-recited elements from claim 2 that are missing from the Krause patent. Therefore, the Section 103 rejection of claim 2 is believed moot and it is respectfully requested that the rejection of claim 2, as well as the claims that depend therefrom, be withdrawn.

Regarding independent claims 17, 23, 27 and 30, similar amendments to those made and discussed above in relation to claim 2, have been made to claims 17, 23, 27 and 30 to overcome the Section 103 rejection of these claims. Therefore, for at least those reasons given above for claim 2, the above-cited Section 103 rejection of claims 17, 23, 27 and 30, as well as those claims depending, respectively, therefrom, is also believed moot. Accordingly, it is respectfully requested that the rejection of claims 17, 23, 27 and 30, and the claims depending, respectively, therefrom, be withdrawn.

Claims 2, 5 through 15, 17 through 21 and 23 through 30 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,675,507 to Bobo, II in view of U.S. Patent No. 5,870,089 to Fabbio. Claims 2, 7, 17, 23, 27, 30 and 31 have been amended to overcome the Section 103 rejection.

There is nothing in the Bobo, II patent that discloses or suggests "processing said primary document <u>to locate</u> an <u>un-selected</u> indicator; identifying said secondary document <u>associated with</u> said <u>located un-selected</u> indicator . . .," as recited in claim 2. Instead, the Bobo, II patent discloses a Message and Storage Delivery System (MSDS) that receives and stores facsimile, voice and data messages and notifies the recipient of the messages via a generated e-mail that a message has been received (see Abstract). Specifically, the Bobo, II patent MSDS operates by receiving a message (primary document) (step 50) for

an intended recipient, storing the message (step 54) for the intended recipient, notifying the intended recipient of the message (step 56), <u>converting the message to an HTML document (tertiary document) based on user preferences</u> (step 58), receiving a request from the intended recipient for information on the stored message (step 76), <u>generating a</u> **<u>separate listing</u>** (secondary document) of the received message and other messages either with or without embedded HTML images (tertiary documents) of the message(s) (steps 102, 112, 120, 130 and 150), and moving (sending) the file to the Internet Server (step 104). (See FIGs. 2, 3, 4A and 4B; column 7, lines 3 – 12, 38 – 50; column 9, line 46 – column 10, line 26.) In other words, in the Bobo, II patent, the secondary document is not "attach[ed] . . . to said primary document to encapsulate said secondary <u>document</u> <u>within said primary document</u>," as recited in claim 2. Similarly, there is nothing in the Fabbio patent that discloses or suggests the above-recited element from claim 2 that is missing from the Bobo, II patent. Therefore, the Section 103 rejection of claim 2 is believed moot and it is respectfully requested that the rejection of claim 2, as well as the claims that depend therefrom, be withdrawn.

Regarding independent claims 17, 23, 27 and 30, similar amendments to those made and discussed above in relation to claim 2, have been made to claims 17, 23, 27 and 30 to overcome the Section 103 rejection of these claims. Therefore, for at least those reasons given above for claim 2, the above-cited Section 103 rejection of claims 17, 23, 27 and 30, as well as those claims depending, respectively, therefrom, is also believed moot. Accordingly, it is respectfully requested that the Section 103 rejection of claims 17, 23, 27 and 30, and the claims depending, respectively, therefrom, be withdrawn.

All of the Section 103 rejections of claims 2, 5 through 15, 17 through 21 and 23 through 32 under 35 U.S.C. §103 are believed to be overcome, and it is respectfully requested that a notice of allowance to that effect be issued.

New claims 33 through 41 have been added and include elements similar to those in claims 2, 5 through 15, 17 through 21 and 23 through 32, which are now believed to be allowable over the cited art. Therefore, claims 33 through 41 are similarly believed to be allowable, and it is respectfully requested that a notice of allowance to that effect be issued.

CONCLUSION

In view of the amendments and remarks submitted above, the Applicant respectfully submits that the present case is in condition for allowance, and a notice to that effect is respectfully requested.

The Commissioner is authorized to charge a fee in the amount of $246.00, plus any other fees determined to be due under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Kenyon & Kenyon **Deposit Account No. 11-0600.**
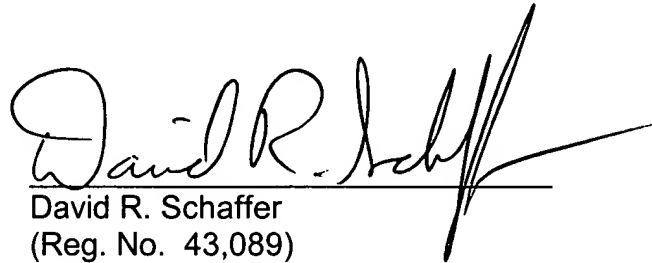
The Examiner is invited to contact the undersigned at (202) 220-4263 to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON

Dated: October 2, 2002   By:

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MARKED-UP VERSION OF AMENDMENTS

IN THE CLAIMS:

Please amend claims 2, 5, 6, 7, 9,17, 23, 27 and 30 as follows:

2.   (Three Times Amended)   A method for identifying a secondary document having an un-specified location relative to a primary document in a document preparation environment comprising:

~~determining if~~ <u>processing</u> said primary document ~~includes~~ <u>to locate</u> an <u>un-selected</u> indicator;

identifying said secondary document ~~by determining at least one of a filename and a location of said secondary document using at least one of a user input, a user-selection and syntactic processing of said primary document, if said primary document includes~~ <u>associated with</u> said <u>located un-selected</u> indicator; and

attaching said secondary document to said primary document to encapsulate said ~~primary and~~ secondary ~~documents together, if said primary document includes said indicator.~~ <u>document within said primary document.</u>

5.   (Twice Amended)   The method according to claim 2, wherein said ~~primary document~~<u>unselected</u> indicator includes at least one word, and wherein ~~determining at least one of~~ said <u>identifying</u> ~~filename and said location of~~ said secondary document is performed as a function of said at least one word.

6.   (Twice Amended)   The method according to claim 2, wherein said ~~primary document~~ <u>unselected indicator</u> includes a plurality of words, and wherein ~~determining at least one of~~ said <u>identifying</u> ~~filename and said location of~~ said secondary document is performed as a function of said plurality of words within a predetermined proximity of said <u>un-selected</u> indicator included in said plurality of words.

7.   (Twice Amended)   The method according to claim 2, further comprising:

associating a predetermined word with at least one of ~~said~~ <u>a</u> filename and ~~said~~ <u>a</u> location of said secondary document,

wherein said primary document includes said predetermined word, and wherein identifying at least one of said filename and said location of said secondary document is performed as a function of said predetermined word.

9.   (Twice Amended)   The method according to claim 2, wherein ~~determining~~ <u>processing</u> said primary document ~~includes~~ <u>to locate</u> said <u>un-selected</u> indicator is performed using syntactic processing

17.   (Twice Amended)   A document preparation system for identifying a secondary document having an un-specified location from a primary document comprising:

a first storage device ~~storing~~ <u>to store</u> said primary document;

a second storage device ~~storing~~ <u>to store</u> said secondary document;

a third storage device ~~storing~~ <u>to store</u> an indicator; and

a processor coupled to said first storage device, said second storage device and said third storage device, said processor ~~determining if~~ to process said primary document ~~includes said~~ to locate an un-selected indicator, ~~identifying~~ identify said secondary document ~~by determining at least one of a filename and a location of said secondary document using at least one of a user input, a user selection and syntactic processing if said primary document includes~~ associated with said located un-selected indicator, and ~~attaching~~ attach said secondary document to said primary document to encapsulate said ~~primary and~~ secondary ~~documents together, if~~ document within said primary document ~~includes said indicator~~.

23.   (Amended)   A document preparation system comprising:

a storage device;

a set of instructions stored on the storage device; and

a processor ~~executing~~ to execute said set of instructions to perform a method to identify a secondary document having an un-specified location relative to a primary ~~document by~~ document, said method comprising:

~~determining if~~ processing said primary document ~~includes~~ to locate an un-selected indicator;

identifying said secondary document ~~by determining at least one of a filename and a location of said secondary document using at least one of a user input, a user selection and syntactic processing of said primary document, if said primary document includes~~ associated with said located un-selected indicator; and

attaching said secondary document to said primary document to encapsulate said ~~primary and~~ secondary ~~documents together, if said primary document includes said~~

~~indicator.~~ document within said primary document.

27.   (Amended)   A method for identifying an unspecified address of a recipient of a primary document in a document preparation environment comprising:

~~determining if~~ processing said primary document ~~includes~~ to locate an un-selected indicator, said primary document having a list of at least one address;

identifying an address of said recipient ~~by determining said address of said recipient using at least one of a user input, a user selection and syntactic processing if said primary document includes~~ associated with said located un-selected indicator; and

attaching said address of said recipient to said list of said at least one address to encapsulate said address of said recipient ~~with~~ within said primary document~~, if said primary document includes said indicator~~.

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30.   (Amended)   A document preparation system comprising:

a storage device storing a set of instructions;

a processor executing said set of instructions to identify an unspecified address of a recipient of a primary document, said primary document including a list of at least one address corresponding to at least one recipient to receive said primary document, by:

determining if processing said primary document includes to locate an un-selected indicator, said primary document having a list of at least one address;

identifying an address of said recipient by determining said address of said recipient using at least one of a user input, a user selection and syntactic processing if said primary document includes associated with said located un-selected indicator; and

attaching said address of said recipient to said list of said at least one address to encapsulate said address of said recipient with within said primary document, if said primary document includes said indicator.

31.   (Amended)   The method of claim 2, wherein said using syntactic processing of said primary document identifying said secondary document comprises using natural language processing techniques.